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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/443,456 11/19/99 WEGENER

K 852/48375

EXAMINER

QM32/0409
EVENSON MCKEOWN EDWARDS & LENAHAH PLLC
1200 G STREET NW SUITE 700
WASHINGTON DC 20005

BRIGGS, W ART UNIT	PAPER NUMBER
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3722
DATE MAILED:

04/09/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09 / 443456

Applicant(s)

WEGENER dJ

Examiner

BRIGGS

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/8/01
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10

- 18) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by

Ressencourt.

Note that as broadly claimed the machining laser in Ressencourt is operable to carry out machining of a workpiece in a forming system.

Claims 19- 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Arai et al, JP 5-96329.

See figure 1 wherein a laser head is located within the tool "bottom part" of the forming die system. Note that a "manipulation device" is provided to move at least part of the laser.

Claims 1-8, 10,11, 17, 18, 23, 25 and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al, EP 0615799.

Hashimoto et al teaches a "forming system" with at least one "forming tool" comprising dies 5-8 that are operative to form a workpiece 9. At least one machining device, "laser process machine 12," that is "integrated into the forming system" as broadly claimed, that would have a "local energy feed" as is necessary to power the laser, is provided. Note that the laser tool comprises

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at least in part “a machining element” and “electromagnetic energy” is conferred by the laser to machine the workpiece. Note further that the laser process machine is mounted to be movable at least in two transverse directions upon a “manipulation device” as shown in figure 2 which would thus be “movable in multiple planes”. Note that Hashimoto et al explicitly sets forth a “control mechanism 18 having a program stored therein...” which anticipates the subject matter of claim 10. Also, the process of claims 27-30 would clearly be achieved in the use of the apparatus of Hashimoto et al.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al.

Note that Hashimoto et al does not teach the use of plural machining tools “parallel to one another,” or placement of the machining device “between two forming stations” but such duplication of the machining device and placement of the machining device of Hashimoto et al would be obvious to one possessing ordinary skill in the art as an obvious design choice as the salient machining would remain unchanged regardless of the chosen placement of the device and

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would be contingent upon, for example, the desired number of machining operations to be performed upon a particular workpiece.

Claims 9 and -12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al as cited above and further in view of Koser, 4,043,167.

Further, the “manipulation device” permutations of claims 9-16, such as “swiveling” means, a “swivel arm” or “parallel-kinematics robot, ” and a “gantry” constitute well-known support and movement providing means for machining tools as shown by Koser, 4,043,167 wherein, for example, the provision for “swivel arms” supporting a machining device in a “forming system” is explicit. One possessing ordinary skill in the art would be expected to readily incorporate such particular “robot” manipulation devices to support the machining tool of Hashimoto et al. Note that it is established that it is obvious to provide automatic means to replace manual activity, the manual control or device which has accomplished the same result. See *In re Venner et al*, 1959 CD 174, 120 USPQ 192.

Claim Rejections - 35 USC § 112

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, no means are set forth in the claims to support the claimed function “movable in a path-controlled manner. In claims 1 and 19, the claimed “separate station” is unclear as no other station from which the cited station is “separate” is explicitly claimed. Further, the scope of the

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claimed “local energy feed” is unclear as, for example, no delineation of how the “energy feed” may be “local” relative to other recited structure of the system is found in the claims. In claim Claim 27 provides for the use of “a machining device”, but, since the claim does not set forth any steps involved in the method/process, other than “carrying out a machining of the workpiece” which is the inherent function or use of a “machining device” it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 27 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Response to Arguments

Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communication from the examiner should be directed to William Briggs who may be reached at (703) 308-1739 during his normal duty hours of 7:30 a.m. to 6:00 p.m., Tuesday through Friday. Messages may be left with the Technology Center 3720 receptionist who may be reached Monday through Friday between the hours of 8:30 a.m. to 5:00 p.m. at (703) 308-1148. In order to reduce pendency and avoid potential delays, Technology Center 3720 is encouraging FAXing of responses to Office Actions directly into the Technology Center 3720 at (703)305-3579. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Technology Center 3720 will be promptly forwarded to the examiner.



WILLIAM BRIGGS
PRIMARY PATENT EXAMINER
ART UNIT 3722